

Remarks

Claims 1-18 and 107-112 are pending in the application. Claims 1-3, 5-7, 10, 11, 13, 14, 16, and 17 have been amended. Claims 19-106 were drawn to non-elected groups and, therefore, they have been canceled without prejudice. Support for the claim amendments and cancellations can be found throughout the application, including the specification and claims as originally filed. Claims 107-112 are new. Support for the new claims can be found throughout the application, including the specification and claims as originally filed. Specifically, see Figures 4 and 5, pages 205 and 206. Therefore, no new matter has been added.

Importantly, the claim amendments and cancellations should not be construed to be an acquiescence to any of the claim rejections. Rather, the amendments and cancellations are being made solely to claim more clearly the invention, to expedite the prosecution of the instant application, and to conform with the election in response to the Restriction Requirement. The Applicants expressly reserve the right to further prosecute the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 U.S.C. § 120 and § 121.

Favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Election/Restriction

The Applicants affirm the provisional election of Group I, claims 1-18, made during a telephone conversation with the Examiner on May 8, 2006. Accordingly, claims 19-106, drawn to non-elected groups, have been canceled without prejudice.

Claim Rejections Based on 35 U.S.C. § 112

Claims 3-19 stand rejected under 35 U.S.C. § 112¶2 as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner contends that substituent R₃ has not been defined in the claims and thus renders the claims indefinite. The Applicants respectfully disagree.

The Applicants respectfully point out that the substituent to which the Examiner objects properly indicates a silicon substituted with three “R” moieties; i.e., “-SiR₃.” For clarification only, Applicants have amended “-SiR₃” in claims 1 and 3 to read “-Si(R)₃.” The amendments do

not reflect a change in the scope of the invention for which protection is sought. As a result, the Applicants submit that claims 3-19 are definite, and respectfully request the withdrawal of claim rejections based on 35 U.S.C. § 112¶2.

Claim Rejections Based on 35 U.S.C. § 102

Claim Rejections Based on 35 U.S.C. § 102 (b)

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tomori *et al.* (*Journal of Organic Chemistry*, **2000**, 65(17), 5334-41; “Tomori”); Old *et al.* (*Organic Letters*, **2000**, 2(10) 1403-1406; “Old”); and Aranyos *et al.* (*Journal of the American Chemical Society*, **1999**, 121(18), 4369-78; “Aranyos”). The Examiner contends that Tomori, Old, and Aranyos disclose compounds that are encompassed by the claims of the instant application. The Applicants respectfully disagree.

In order to expedite prosecution, the Applicants have amended claim 1 to remove “alkyl” and “aryl” from the Markush group defining R₁ and R₂ in claim 1. Therefore, the Applicants respectfully assert that amended claim 1 is not anticipated by Tomori, as claim 1 reads on compounds of the Tomori reference *if and only if* the definition of “R₁” or “R₂” in structure limitation I encompasses “methyl” or “isopropyl.” Moreover, claim 1 reads on compounds of the Old reference *if and only if* the definition of “R₁” or “R₂” in structure limitation I encompasses “isopropyl.” Similarly, claim 1 reads on compounds of the Aranyos reference *if and only if* the definition of “R₁” or “R₂” in structure limitation I encompasses “aryl.”

The Applicants respectfully point out that in amended claim 1, “R₁ and R₂” are defined as “when present, are selected independently for each occurrence from the group consisting of ethyl, propyl, butyl, pentyl, hexyl, cycloalkyl, heterocycloalkyl, heteroaryl, aralkyl, heteroaralkyl, -Si(R)₃, and -(CH₂)_m-R₈₀.” Support for this amendment can be found in the specification as originally filed. *See Specification* pages 51-52. The Applicants respectfully submit that none of the compounds disclosed in the Tomori, Old and Aranyos references fall within the scope of amended claim 1.

The Applicants respectfully remind the Examiner that in order to anticipate a claim, a single source must contain all of the elements of the claim. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v.*

E.I. duPont De Nemours & Co., 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *See Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). The Applicants contend that dependent claim 2 is not anticipated by Tomori, Old, or Aranyos because it depends from independent claim 1, which does not read on any compounds disclosed in said references.

Accordingly, the Applicants respectfully request the withdrawal of the claim rejections under 35 U.S.C. § 102(b) based upon the Tomori, Old, and Aranyos references.

Claim Rejections Based on 35 U.S.C. § 102 (a)

Claims 3-6, 8-11, 13-14, and 16-17 are rejected under 35 U.S.C. § 102(a) as being anticipated by Huang *et al.* (*Journal of the American Chemical Society*, 125(22), 2003, 6653-65; “Huang”). The Examiner contends that Huang discloses compounds that are encompassed by the claims of the instant application. The Applicants respectfully disagree.

In order to expedite prosecution, the Applicants have amended claim 1 to remove “alkyl” from the Markush group defining “R.” As a result, the Applicants respectfully assert that amended claim 3 is not anticipated by Huang, as claim 3 reads on compounds of the Huang reference *if and only if* the definition of “R” in structure limitation II encompasses “t-butyl” or “ethyl.” The Applicants respectfully point out that in claim 3, “R” is defined as “selected independently for each occurrence from the group consisting of cycloalkyl, and $-(CH_2)_m-R_{80}$.” Notably, this definition does not include “t-butyl” or “ethyl.” As such, the Applicants respectfully submit that none of the compounds disclosed in the Huang reference falls within the scope of rejected claim 3.

As discussed above, in order to anticipate a claim, a single source must contain all of the elements of the claim. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. duPont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *See Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). The Applicants

contend that dependent claims 4-6, 8-11, 13-14 and 16-17 are not anticipated by Huang as they depends from independent claim 3, which does not read on any compounds disclosed in Huang.

Accordingly, the Applicants respectfully request the withdrawal of the claim rejections under 35 U.S.C. § 102(a) based upon the Huang reference.

Fees

The Applicants believe they have provided for all no required fees in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any additional required fee to our Deposit Account, **06-1448** reference **MTV-014.05**.

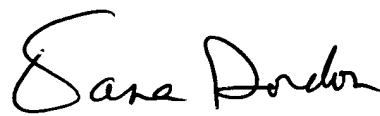
Conclusion

In view of the above remarks, the Applicants believe that the pending claims are in condition for allowance. If a telephone conversation with Applicant's Attorney would expedite prosecution of the application, the Examiner is urged to contact the undersigned.

Respectfully submitted,
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